Remarks

Amendments to the claims

Claims 1, 9, 18 and 21 have been amended by adding that the command causes the web user computer to execute the web page file. Support for this amendment is found in the specification at page 7 lines 8-9.

Rejection of Claims under 35 U.S.C. § 102

Claims 1-5, 8-9, 12, 14-17 and 21 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,466,966 B1 ("Kirsch").

The Applicants respectfully disagree that claims 1-5, 8-9, 12, 14-17 and 21 are anticipated by Kirsch.

As a starting point, the PTO and the Federal Circuit provide that §102 anticipation requires each and every element of the claimed invention to be disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. (*Kloster Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)). Furthermore, "[a]nticipation requires that all of the elements and limitations of the claims are found within a single prior art reference." (*Scripps Clinic and Research Found. v Genetech. Inc.,* 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (emphasis added)). Moreover, the PTO and the Federal Circuit provide that §102 anticipation requires that there must be no difference between the claimed invention and the reference disclosure. (*Scripps Clinic and Research Found. v. Genetech, Inc.,* id. (emphasis added)). Accordingly, if the Applicants can demonstrate that any one element or limitation in claims 1-5, 8-9, 12, 14-17 and 21 is not disclosed by Kirsch, then the respective claim(s) must be allowed.

In the following arguments, the Applicants will focus in particular on independent claims 1, 9 and 21, as the Applicants believe those claims to be allowable (as amended above) over Kirsch. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable, and therefore the Applicants do not believe it is necessary to present arguments in favor of each and every dependent claim.

Claim 1

The Applicants contend that claim 1, as amended (and rejected claims 2-5 and 8 which depend therefrom) are not anticipated by Kirsch.

The Applicants believe that the followings tables may help to clarify the differences between Applicants' claim 1 and what is disclosed by Kirsch.

TABLE 1

Applicants Claim 1

WEB USER COMPUTER	WEB TOOL	SERVER
Access the web tool.		
	· Provide a web page file; · insert a "command" having embedded user info into the web page file; · designate a server within the command; · transmit the web page file to the user computer.	
Transmit directly to the server a "request" that includes the user info (caused by the commend)		
		· Process the request; · store the user info in a db (caused by processing the request)

(Continued on next page.)

TABLE 2 Method disclosed by Kirsch			
CLIENT SYSTEM	**IBS SERVER**	**FIRST SERVER**	**SECOND SERVER**
· Access IBS server · select hyperlink for second server from IBS server.			
	· Provide hyperlink to second server; · insert URL for second server in hyperlink; · insert accounting information into hyperlink; · insert URL for first server in hyperlink; · transmit hyperlink to client system.		
· User clicks on hyperlink; · access first server.			
		· Record accounting information; · generate a redirect to the URL for the second server; · transmit redirect to the client system.	
Process the redirect to connect to the second server.			
			Transmit second server information to client system.
Receive second server information.			

Comparison of Table 1 and Table 2

Equivalent terms between Applicants' claim 1 and Kirsch:

- Applicants' "user computer" ≈(is essentially equivalent to) Kirsch's "client system";
- Applicants' "user information" ≈Kirsch's "accounting information";

- Applicants' "server" ≈Kirsch's "first server" (due to the fact that Applicants' "user information" and Kirsch's "accounting information" are stored on this server).

Terms at issue between Applicants' claim 1 and Kirsch (with no particular relationship being implied based on the following table):

Applicants	Kirsch
web tool	IBS server
web page file	hyperlink
command	
request	URL for first server
	URL for second server
	redirect
	second server

Arguments why Kirsch does not anticipate Applicant' claim 1:

As a preliminary matter, Kirsch's use of apparently interchangeable terms provides for a difficult comparison between what is disclosed by Kirsch and what is claimed by the Applicants. For example, Kirsch seems to use the terms "informational element" (Col. 5 lines 15-27), "embedded hyperlink reference" (Col. 6, lines 47-48), and "a client reference to a resource locator independently selected by a client computer system and referencing a server external resource" (Kirsch claim 1, Col. 16 lines 12-14) interchangeably. It appears that all of these terms refer to the same thing, being a hyperlink that is provided to a client system (user computer) by an IBS server (Applicants' "web tool"), and which allows the user to access an external resource (i.e., a web site other than the web site which provides the hyperlink itself). The Applicants contend that, notwithstanding this apparent confusion, a careful reading of Kirsch reveals the differences between what is disclosed by Kirsch and what is claimed by the Applicants. Specifically:

Assuming, for the sake of argument only, that Applicants' "web tool" (which provides the "web page file" to a user computer) is equivalent to Kirch's "IBS server"

(which provides a "hyperlink" to a client system), and that Applicants' "web page file" is equivalent to Kirsch's "hyperlink", then the method of Applicants' claim 1 is different from what is disclosed by Kirsch. Specifically, Applicants' claim 1 recites inserting a "command" in the web page file, and that the command causes the user computer to execute the web page file and to transmit directly to the server a "request" that includes the user information. Kirsch does not provide for a "command" to be included in the hyperlink that is transmitted to the user computer. Kirsch only provides for inserting a URL for a first server, a URL for a second server, and accounting data into the hyperlink. The Applicants' contend that neither of the two URL's of Kirsch, nor the "accounting data" of Kirsch, can be considered equivalent to Applicants' "command". Specifically, as described above, Kirsch's "accounting data" is generally equivalent to Applicant's "user information". Accordingly, only Kirsch's URL's for the first and second servers are left for comparison to Applicants' "command." Certainly a URL is not a "command." A URL is an address, whereas a command is an executable instruction. Applicants' "command" can include an address to Applicants' "server" (see Applicants' Fig. 2C, with address 210), however, as can be seen in Fig. 2C, the command also includes executable steps for "causing the web user computer to execute the web page file and transmit directly to a server . . . a request", as recited in Applicants' claim 1. Certainly the URL's of Kirsch cannot "cause a web user computer to execute a web page file and transmit directly to a server . . . a request". In fact, as expressly described and depicted by Kirsch, Kirsch requires the user to "click" on the hyperlink in order for the accounting information to be subsequently sent to the first server. (See Kirsch Col. 5 lines 21-23 ("selection [i.e., clicking on] the information element [i.e., hyperlink] causes the client system [i.e., user computer] to use the tracking resource locator to provide the [accounting] data to the tracking server . . . ."; see also Kirsch Col. 6 lines 45-50 (". . . Web page element that is selectable, or clickable,

by a user . . ."; see also Kirsch Figs 6 and 7, respective items 96 and 98 - "Click Banner"). Not to belabor the point, but in Applicants' claim 1, the "command" causes the user information to be sent to the server, whereas in Kirsch, the user causes accounting information to be sent to a server by "clicking" on a hyperlink. That is, Applicants' **command** executes the web page file; in Kirsch, the **user** executes the Hyperlink. It is fundamental that URL's cannot execute a hyperlink, which is what Kirsch's URL's for the first and second servers would need to do if they were to be considered as equivalent to Applicants' "command".

For at least these reasons the Applicants contend that claim 1, and claims 2-5 and 8 which depend therefrom, are not anticipated by Kirsch.

Further, with particular respect to Applicants' claim 3, the Applicants contend that nothing in Kirsch teaches or suggests using a "Broken Image Tag" ("BIT") that is embedded in a BIT URL. The Examiner has cited Kirsch at Col. 8 lines 19-40, and Col. 12 lines 5-15, as support for the specific rejection of claim 3. However, the Applicants see nothing in those cited sections, or anywhere else in Kirsch, which refers to a "Broken Image Tag", or its equivalent, being inserted into a "command". To the extent that the cited sections of Kirsch do refer to an image tag (which the Applicants' do not concede), there is certainly no reference to a "Broken Image Tag", which is a special kind of image tag.

Moreover, with particular respect to Applicants' claim 5, nothing in Kirsch teaches or suggests storing the user information ("accounting data" of Kirsch) in an error log. Kirsch only describes storing accounting data in a "tracking server" (Col. 5, lines 23-25). The Examiner cites Kirsch at Col. 11 lines 39-45 for support in rejecting claim 5. That section merely discusses storing the "data identifying the client system" in a database, and thereafter generating a redirect message to thereby redirect the user computer to the second server. The error log of Applicants' claim 5

is a special kind of database, and not just the generic "database" described by Kirsch.

For at least these reasons the Applicants contend that claims 1-5 and 6-8 are not anticipated by Kirsch.

Claim 9

The Applicants contend that claim 9, and claims 10-17 which depend therefrom, are not anticipated by Kirsch. With respect to independent claim 9, that claim includes the following limitations:

> A system for tracking web users use of a web tool, comprising:
>
> a web tool server [] for providing to each web user computer one or more web page files [], the web tool server inserting within at least one of the web page files [] a **command** having embedded user information associated with a web user's use of the web tool; and
>
> a designated server [], wherein the **command** *when executed by a web user computer* **causes** the web user computer to **execute the web page file** and transmit to the designated server a request that includes the embedded user information, wherein the user information is stored in a database in response to the request being processed by the designated server.
>
> (Emphasis added.)

As can be seen, in Applicants' tracking system of claim 9 the **"command"** *causes* the user computer to execute the web page file and transmit to the designated server a "request" that includes the embedded user information. As described above with respect to claim 1, Kirsch does not teach or suggest

transmitting a web page file (Kirsch's "hyperlink") to a user computer, wherein the web page file includes a **command** that *executes* the web page file.] In Kirsch, the web page file ("hyperlink") is executed by the user, by way of the user "selecting" or "clicking" the hyperlink.

For at least these reasons, the Applicants contend that claim 9, and claims 10-17 which depend therefrom, are not anticipated by Kirsch.

Further, specifically regarding claim 12, Kirsch simply does not teach or suggest including a "Broken Image Tag" ("BIT") in a "request" (generally equivalent to Kirsch's URL to a second server), or more generally, the use of a BIT which causes an error to be generated by an Internet program.

With specific regard to claims 14 and 15 (and claim 16 which depends from claim 15), the Applicants contend that Kirsch does not teach or suggest the use of a "Broken Image Tag" ("BIT") for storing user information in a database. As described above with respect to claim 3, to the extent that Kirsch does teach or suggest the use of an image tag (which the Applicants' do not concede), Kirsch does not teach the use of a *Broken* Image Tag, which is a special kind of image tag.

For at least these reasons the Applicants contend that claims 9, 12 and 14-17 are not anticipated by Kirsch.

Claim 21

The Applicants contend that claim 21 is not anticipated by Kirsch. With respect to claim 21, that claim includes the following limitations:

> A computer program product for tracking the use of a web tool by a web user, the product having computer readable instructions thereon that when executed cause a computer to perform the following acts:

. . .

inserting within at least one of the web page files a **command** having embedded user information associated with the web user's use of the web tool, the command causing the web user computer to **execute the web page file** and transmit to a server, designated within the command, a request that includes the embedded user information, wherein the user information is stored in a database in response to the request being processed by the designated server.

(Emphasis added.)

As can be seen, in the Applicants' computer program for tracking the use of a web tool of claim 21, the program causes a "command" to be inserted into a web page, and the "command" causes the web user computer to **execute the web page file**. As described above with respect to claim 1, Kirsch does not teach or suggest transmitting a web page file (Kirsch's "hyperlink") to a user computer that includes a **command** that *executes* the web page file. In Kirsch, the web page file ("hyperlink" is executed by the user, by way of the user "selecting" or "clicking" the hyperlink.

For at least this reason, the Applicants contend that claim 21 is not anticipated by Kirsch.

For all of the reasons stated above, the Applicants contend that claims 1-5, 6-9, 12, 14-17 and 21 are not anticipated by Kirsch. The Applicants therefore request that the rejection of these claims as being anticipated by Kirsch be removed and the claims allowed.

(Continued on next page.)

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 6, 7, 10, 11, 13 and 18-20 have been rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,466,966 B1 ("Kirsch") in view of Morimoto et al (US 6,397,244) ("Morimoto").

The Applicants respectfully disagree that claims 6, 7, 10, 11, 13 and 18-20 are obvious over Kirsch in view of Morimoto.

As a starting point, MPEP 706.02(j) states:

> "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must** teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure." (Emphasis added.)

With respect to claims 6 and 7, those claims depend from claim 1. With respect to claims 10, 11 and 13, those claims depend from claim 9. For the reasons stated above, the Applicants contend that claims 1 and 9 are allowable. It is axiomatic that any claim which depends from an allowable claim is also allowable. Accordingly, claims 6, 7, 10, 11 and 13 are also allowable since they inherently include the limitations of claim 1 (for claims 6 and 7) and claim 9 (for claims 10, 11 and 13).

With specific regard to clams 6, 7, 11 and 13, and the rejection thereof, the Examiner states in the Office action at page 4, paragraph no. 2, first sub-paragraph, "Kirsch teaches the request [of Applicants independent claims 1 and 9] is a request for retrieving an image file from the designated server." (Emphasis added.) The Applicants' respectfully disagree. Referring to Tables 1 and 2 above (and claims 1 and 9), it is clear that the Applicants' "request" is a request to store the information in a database. It is not a request to retrieve an image file. In Applicants claims 1 and 9, the desired image file ("web page file") has already been received **prior to** the request being processed. This highlights a fundamental difference between the Applicants' claimed invention and what is disclosed by Kirsch. The Applicants' claimed invention is directed towards tracking use of a web tool, whereas Kirsch is directed towards tracking access to a "web tool" via a hyperlink. In the Applicants' invention, access to the web tool is primarily established, and thereafter the access to the web tool is recorded in a "server." (See Table 1, above.) In Kirsch, on the other hand, a "hyperlink" is primarily acquired, and, upon accessing the hyperlink by "clicking" on the hyperlink, the client's access to a second server is recorded, and thereafter (via the "redirect") final access to a desired web page ("second sever") is established. (See Table 2, above.)

Further, although Morimoto describes the use of an error log ("a data file for storing error analysis", Morimoto, Abstract), this use is described in Morimoto within the realm of tracking errors, and not for "storing user information", as is required by Applicants' claims 6, 7, 10, 11 and 13. Such use of an error log by the Applicants is a **non-conventional** (i.e., non-obvious) use of an error log. It will be appreciated that an error log is typically provided to log non-intentional errors, and **not** for the purpose of intentionally logging user information. Neither Kirsch nor Morimoto teach or suggest the use of an error log for the purposes of intentionally recording user information.

For at least these reasons the Applicants contend that claims 6, 7, 10, 11 and 13 are not obvious over Kirsch in view of Morimoto.

With respect to claims 18-20, independent claim 18 (and thus, inherently, dependent claims 19-20) include the following limitations:

> A web tool system having a capability of tracking a user's use of a web tool, comprising:
>
> a web tool server [] having a web tool program for generating and providing to the web user computer one or more web page files [];
>
> a designated server []; and
>
> a user information database server communicatively linked to the designated server, wherein the web tool program inserts into at least one of the one or more web tool pages for a web user session, **a command** having embedded user information associated with the web user's use of the web tool, **the command causing the web user computer to execute the web page file** and transmit to the designated server a request that includes the embedded user information, wherein the designated server transfers the user information from the request to the user information database in response to processing the received request.
>
> (Emphasis added.)

As can be seen, in the web tool system of Applicants' claim 18, the command inserted by the web tool program into the web page not only includes the user information, but also causes the web user computer to **execute the web page file** and transmit a request to the designated server that includes the user information. Neither Kirsch nor Morimoto show this limitation. As described above with respect to

claims 1, 9 and 21, Kirsch does not teach or suggest transmitting a web page file (Kirsch's "hyperlink") to a user computer that includes a **command** that *executes* the web page file. In Kirsch, the web page file ("hyperlink") is executed by the user, by way of the user "selecting" or "clicking" the hyperlink. Likewise, Morimoto does not teach or suggest a web tool server that inserts a command into a web page, wherein the command executes a web page file, all as required by Applicants' claim 18.

Further, with respect to claim 19, neither Kirsch nor Morimoto teach or suggest causing a server to generate a broken image error for purposes of tracking user information. The error recording system of Morimoto is for the purpose or recoding unintentional errors (which inherently occur only when an unintentional error arises), and **not** for the purposes of tracking user information regardless of whether an unintentional error arises or not (as is inherently required by Applicants' claim 19).

Finally, with respect to claim 20, the Applicants contend that nothing in Kirsch or Morimoto teaches or suggests using a "Broken Image Tag" ("BIT") that is embedded in a BIT URL as a "command" for the purposes of transferring user information to a user information database, as is required by Applicants' clam 20.

For at least these reasons, the Applicants contend that claim 18, and claims 19-20 which depend therefrom, are not obvious over Kirsch in view of Morimoto.

For at least all of reasons stated above, the Applicants contend that claims 6, 7, 10, 11, 13 and 18-20 are not obvious over Kirsch in view of Morimoto, and therefore respectfully request that the rejection of these claims be removed and the claims allowed.

Summary

The Applicants believe that this response constitutes a full and complete response to the Office action, and therefore request timely allowance of claims 1 through 21.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

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